

**REMARKS**

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

By the foregoing amendment, claims 1, 16, and 24-29 have been amended and claims 31 and 32 have been amended. Claims 10, 21, and 30 were previously canceled. Thus, claims 1-9, 11-20, and 22-33 are currently pending in the present application and subject to examination.

In the Office Action mailed April 13, 2006, the Examiner rejected claims 1-9, 11-20, and 22-29 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Claims 1, 16, and 24 have been amended responsive to this amendment. The amendment has support on page 24, lines 14-15 of the present application. The amended term states "wherein the viewer is limited to receiving a determined number of electronic books at a time from the controller" and lines 14-15 state "It is preferred that the public viewer be limited to receiving one or two books at a time from the controller." The controller is taught as monitoring the data being transferred, so that the controller is limited to downloading to only authorized viewers and is limited to downloading a chosen number of books at a time. As the controller monitors the data transferred, the controller would be capable of determining the number of electronic books that have been downloaded. Claim 32 further narrows the determined number to one or two books. Therefore, the Applicant submits that claims 1-9, 11-20, and 22-29, as amended comply with the written description requirement and respectfully request the withdrawal of their rejection.

The Examiner rejected claims 1-9, 11-14, 16-20, 24, and 25, and 27-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,634,064 to Warnock et al. ("Warnock") in view of U.S. Patent No. 5,239,665 to Tsuchiya et al ("Tsuchiya"). The Examiner rejected claims 15, 22, 23, and 26 under 35 U.S.C. § 103(a) as being unpatentable over Warnock in view of Tsuchiya and further in view of what would have been obvious to one of ordinary skill in the art. It is noted that claims 1, 16, and 24-29 have been amended. To the extent that the rejections remain applicable to the claims currently pending, the Applicant hereby traverses the rejection, as follows.

Applicants invention as now set forth in claim 1 is directed to a system for accessing electronic books including a file server that stores electronic books, a controller connected to the file server for controlling access to electronic books on the file server, and a viewer adapted for connection to the controller, which viewer stores and displays electronic books, wherein the viewer is limited to receiving a determined number of electronic books at a time from the controller.

Tsuchiya teaches an electronic book and an automatic vending machine. However, the Applicants submit that Tsuchiya does not disclose or suggest the system including a viewer limited to receiving a determined number of electronic books at a time from a controller, as claimed in amended claim 1. Warnock fails to cure this deficiency in Tsuchiya.

For at least this reason, the Applicant submits that claim 1 is allowable over the cited art. The Applicant submits that claims 16 and 24 are likewise allowable.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of

obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 9. This is an insufficient showing of motivation.

Furthermore, regarding the rejection of claims 15, 22, 23, and 26, the Examiner takes Official Notice that deleting stored files after a specific period of time from a client's memory is known citing JP405334167A ("167") The Applicant respectfully traverses the characterization of this patent.

'167 teaches a deleting or copying a file coincident with determined information from a file server computer to a client computer *at the time of connecting or*

*disconnecting the client computer to/from the file server computer.* Thus, the deletion taught by 167 occurs based on information in the file server computer at the points at which the client computer is either connected or disconnected.

Claim 14 claims the viewer uses an automated timeout sequence that erases textual data for the selected electronic books after a period of time. In contrast to '167, the timeout sequence is used by the viewer, not the file server. In addition, the viewer uses an automatic timeout sequence rather than a deletion that occurs at connection or disconnection to the file server.

For at least this reason, the Applicant submits that claim 14 is allowable over the cited art. The Applicant submits that claims 22 and 26 are likewise allowable.

The Examiner also took official notice that converting a video signal to an electronic document is known, citing JP406068339A ("339"). The Applicant respectfully traverses the use of this reference as showing the knowledge in the art at the time the invention was made, because the publication date of the reference is March 11, 1994, which is after the priority date of the present application. The use of a video connector that receives a signal from a distribution system, converts the signal into electronic book files, and stores the electronic book files to the file server is supported, at least, in U.S. Patent No. 5,990,927 filed on December 3, 1993, from which the present application depends, in column 5, line 60-column 6, line 23 and column 28, lines 10-22.

Furthermore, the Applicant submits that no motivation whatsoever to combine the teachings of either '167 or '339 with the teachings of Warnock and Tsuchiya is provided.

For at least these reasons, the Applicant submits that claims 15, 22, 23, and 26 are allowable over the cited art. The Applicant submits that claim 14 is likewise allowable.

Thus, the Applicants submit that claims 1, 16, and 24 are allowable over the cited art, for at least the reasons described above. The Applicants submit that claims 2-9, 11-15, 17-20, 22-23, 25, 27-29, and 31-33, which each depend from allowable claims 1, 16, and 24, are, therefore, also allowable for at least the above noted reasons and for the additional limitations they provide.

### **CONCLUSION**

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to

Application No. 09/722,742  
Attorney Docket No. 026880-00021

Deposit Account No. 01-2300, with reference to Attorney Docket No. 026880-00021.

Respectfully submitted,

Arent Fox PLLC

A handwritten signature in black ink, appearing to read 'Charles M. Marmelstein', written over the printed name.

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